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10/580,586	05/25/2006	Makoto Kawasaki	287710US8PCT	5562
22850 7590 03/31/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SONG, JASMINE				
ART UNIT		PAPER NUMBER		
2189				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/580,586

Applicant(s)

KAWASAKI, MAKOTO

Examiner

JASMINE SONG

Art Unit

2189

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-33 and 35-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GA-6)
Paper No(s)/Mail Date 1/14/2010 and 03/03/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

This office action is in response to Amendment filed 1/14/2010, claims 1-17 has been cancelled and claims 18-56 are newly added, therefore, Claims 18-56 are pending in the application. All rejections and objections not explicitly repeated below are withdrawn.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Response to applicant's Arguments

Applicant's arguments with respect to claims 18-56 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-33 and 35-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Horiuchi et al., US 2003/0009667 A1.

Regarding claims 18, 38 and 56, Horiuchi teaches an information processing apparatus, comprising:

a network communication unit (Fig.1, it is taught as a carrier 20) configured to download content data from a server (it is taught as a distribution server 10) over a communication network (it is taught as a cellular phone network in Fig.1);

a memory (it is taught as a memory 1024) configured to store the downloaded content data (section 0076, lines 8-10);

a control unit (Fig.5, it is taught as a controller 1022 and section 0097) configured to automatically register, without user operation (section 0138controller 1022 generates list information LST corresponding to content data Dc), identification information of the downloaded content data to a list (section 0076), and to control a display unit (it is taught as a display 1020 in Fig.5) to display information of the downloaded content data in a different way from information of other content data based on the list (section 0156, it is taught as controller 1022 provides various visual information on display according to the executed program); and

a communication unit configured to communicate with an information reproducing apparatus (Fig.14), and to transfer to the information reproducing apparatus the downloaded content data based on the list (section 0153-154).

Regarding claims 19 and 39, Horiuchi teaches the control unit is configured to register, in response to user operation, the identification information of the content data stored in the information processing apparatus to the list (section 0076 and 0138).

Regarding claims 20 and 40, Horiuchi teaches the list is a list of the downloaded content data (section 0076).

Regarding claims 21 and 41, Horiuchi teaches the content data is music data (section 0047, it is taught as motion picture data and audio data, game programs and the like).

Regarding claims 22 and 42, Horiuchi teaches the list is a list of all songs stored in the information processing apparatus (section 0056).

Regarding claims 23 and 43, Horiuchi teaches the control unit is configured to control the display unit to display a button, and to control the communication unit to transfer the downloaded content data in response to an operation of the button (Fig.5 and section 0156).

Regarding claims 24 and 44, Horiuchi teaches further comprising:

a disc drive configured to read a disc, and wherein the control unit is configured to

control the disc drive to read data from the disc and to control the memory to store the read data as the content data (0076).

Regarding claims 25 and 45, Horiuchi teaches the control unit controls the display unit to display a list of the content data stored in the information reproducing apparatus when the information reproducing apparatus is connected to the information processing apparatus (section 0156).

Regarding claims 26 and 46, Horiuchi teaches the control unit is configured to control the network communication unit to download sample data of the content data, and to control reproduction of the sample data (section 0155-0157).

Regarding claims 27 and 47, Horiuchi teaches the control unit is configured to control the network communication unit to receive a price of the content data, and to control the display unit to display the price of the content data (section 0055, lines 7).

Regarding claims 28 and 48, Horiuchi teaches the control unit is configured to control the network communication unit to receive a popularity of the content data, and to control the display unit to display the popularity of the content data (section 0055-0057).

Regarding claims 29 and 49, Horiuchi teaches the identification information of the

downloaded content data is at least one of title, artist name, and album name (section 0056).

Regarding claims 30 and 50, Horiuchi teaches the control unit is configured to control the display unit to display information of the downloaded content data that is transferable to the information reproducing apparatus based on the list, to set an entry corresponding to the downloaded content data to the list, and to execute a display operation with the entry set as transfer-specified content beforehand (Fig.12 and Fig.13A-13B).

Regarding claims 31 and 51, Horiuchi teaches the control unit is configured to store the downloaded content data into the memory, to acquire the downloaded content data from the memory on the basis of the identification information of the downloaded content data registered to the list, and to transfer the acquired downloaded content data to the information reproducing apparatus (Fig.11).

Regarding claims 32 and 52, Horiuchi teaches the control unit is configured to acquire the downloaded content data from the memory on the basis of the identification information of the downloaded content data registered to the list, and to transfer the acquired downloaded content data to the information reproducing apparatus under a condition of a user transfer instruction input (fig.11, S254).

Regarding claim 33, Horiuchi teaches the control unit is configured to acquire the downloaded content data from the memory on the basis of the identification information of the downloaded content data registered to the list and, and to transfer the acquired downloaded content data to the information reproducing apparatus regardless of a user transfer instruction input (fig.11).

Regarding claims 35 and 53, Horiuchi teaches the control unit is configured to acquire a content file name on the basis of the identification information of the downloaded content data and to acquire a content file corresponding to the downloaded content data stored in the memory, on the basis of said content file name (section 0088).

Regarding claims 36 and 54, Horiuchi teaches the control unit is configured to identify content data to be written to an information recording medium on the basis of said identification information (it is taught as storing content data to memory card 110).

Regarding claims 37 and 55, Horiuchi teaches the control unit is configured to control the display unit to display information about content data writable to an information recording medium set as the list, to set an entry corresponding to the downloaded content data to said list, and to execute a display operation with said entry set as write-specified content beforehand (Fig.12, 13A-13B).

Allowable Subject Matter

Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

When responding to the office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the

art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. 1.111 (c).

When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Song whose telephone number is 571-272-4213. The examiner can normally be reached on 9:00am to 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon can be reached on 571-272-4204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jasmine Song/

Primary Examiner, Art Unit 2189

